

Claims 1 to 19 are pending. Claims 1 and 10 have been amended to overcome the Examiner section 112 rejections, and applicant has added claims 20 to 22.

Claims 17 and 19

Claims 17 and 19 have been rejected on the grounds of anticipation in view of Gajor '456. Gajor, however, is very different from applicant's invention.

First, Gajor does not have pairs of hands as that term is used in the applicant's invention. Each hand in Gajor is an individual hand.

Second, Gajor teach a symmetric matrix of cards (i.e., 3 x 3, 5 x 5 and 7 x 7) whereas applicant's invention set forth in claims 17 and 19 does not have a symmetric matrix. Instead, the invention of claims 17 to 19 has a pair of hands, for which Gajor would require at least 10 cards, but applicant's game requires only eight cards. This is important distinction because there are fewer cards known to the player in applicant's invention which increases the difficulty to the player, which in turn increases the pay back to the casino. If the player knew more cards, and the player were also allowed to exchange cards between hands the payout to the player could be well over 100%, which means casinos would be unlikely to use the game. Also, by dealing fewer cards from a deck, multiple hands are easier to display, and more practical. Furthermore, fewer cards displayed in multiple hands game increases the uncertainty and the payback becomes more attractive to casinos.

Third, because Gajor does not have pairs of hands, the two end cards are not common to each hand in the pair. In Gajor, Figure 6, for example, the top right corner card (King of clubs) is common to the hands depicted by paylines 10 and 5, but

the bottom corner card (King of diamonds) is common to the hands depicted by paylines 10 and 1. Therefore, in Gajor the two end cards are divided between three separate hands (at least; they are also common to the diagonal hands). The end cards in Gajor, however, are not common to a pair of hands as required in claims 17 and 19.

Fourth, nothing in Gajor describes or suggests exchanging cards between hands. In Gajor, all the cards are dealt face up and the hands are evaluated. The player in Gajor has no opportunity to move cards from one hand to the other.

Lack of an exchange feature (also called swapping) described in applicant's specification is a critical distinction between applicant's invention and all prior art. Among other things this feature adds an element of skill and strategy because improving one hand may make another hand worse. The player, therefore must evaluate whether the improvement to one hand sufficiently overcomes the detriment to the other hand. Nothing in Gajor or any other prior art reference has this inventive contribution.

By having card exchanges together with face-down cards applicant's invention adds an element of strategy and uncertainty making the game more enjoyable to play. Because the player knows the values of 12 of the 16 cards (in a four hand game) and is then able to exchange cards to improve hands, the game simultaneously requires considerable skill yet also is fun to play.

OBVIOUSNESS REJECTIONS

The Examiner has rejected claims 1 to 15 on the grounds of obviousness over the combination of Gajor and Chilese. Applicant respectfully disagrees with that conclusion.

As explained above, nothing in Gajor discloses exchanging cards between hands. Similarly nothing in Chilese describes exchanging (or swapping) cards between hands. The closest Chilese comes to this is a mechanism where the game computer automatically moves the fifth card located at the outside of a star configuration to the highest paying hand:

“The card ... 30 will automatically move to one of the other four positions that are outside the star if that forms a higher ranked hand ...” (col. 3, lines 27 to 29)

This is not an exchange of cards between hands. After the card is moved from the first hand to the second in Chilese, the first hand no longer exists. The first hand has only four cards, and only the second, a full five-card hand, hand in used. This is not a card exchange. Rather, it is dealing nine cards to make up a five card hand by moving only one selected card, card 30, at the outside of the star, to a preferred position. The strategy (assuming Chilese allowed the player to control the card's movement) is entirely different than in applicant's game.

Indeed, the claim 1 of Chilese states (emphasis added):

“dealing out a geometric pattern of said cards, such that as a five pointed star using ten cards, one to an intersection, with one external **moveable** card to be used with each straight line group of four cards, such that each card is simultaneously used in multiple groups.”

Claim 1 further demonstrates there is no card exchange in Chilese. It is only the external card that moves between hands.

Furthermore, the second part of Chilese states that “each card is simultaneously used in multiple groups.” This is not the case with the present invention. Only the end cards (or corner cards) in applicant’s invention are used in multiple hands. The interior cards, unlike in Chilese, are not common to multiple hands.

Therefore, even if there were some motivation to combine these references, and there is none, the resulting game would be entirely different from applicant’s invention. The shape of the card display would be different, the number and location of any face down cards would be different -- and there would still be no card exchange.

Claims 2-3, 6 and 11

The Examiner has rejected claims 2-3, 6 and 11 over Chilese and Gajor asserting that it would have been obvious to designate which cards are dealt face up or down. However, applicant has reviewed these references and finds nothing in either to suggest that any card is dealt face down. Therefore even if the references were combined, there would be no face down cards anywhere. Moreover, there is nothing in either Gajor or Chilese to suggest or to motivate a person of ordinary skill in the art to deal some of the cards face down in the applicant’s unique card configuration and with the unique exchange requirements.

Claim 16

Claim 16 adds that the player must pay for each card exchange. The Examiner has combined three references, itself a difficult task, to arrive at his conclusion

that claim 16 would have been obvious. However, as explained above, combining Gajor and Chilese does not create the applicant's invention, and Wächtler does not disclose having the player pay to swap cards. The closest Wächtler comes to applicant's innovation is to allow the player to buy new cards (col. 1, lines 6 to 10). However, buying new cards is entirely different from paying to swap existing-dealt cards. Thus, even if all three references were combined, and assuming there was some motivation to combine them, they still would not yield the applicant's invention.

Claim 18

Claim 18 states that the end cards are dealt face down and are revealed after the player has swapped his cards. The Examiner stated that claim 18 is obvious in view of Gajor. However, as previously explained, nothing in Gajor discloses or suggests either dealing cards face down or exchanging cards. Indeed, the Examiner has acknowledged that Gajor does not discuss dealing cards face down. (See paragraph 15).

* * *

In paragraphs 11, the Examiner has concluded:

"By having different kinds of configurations of cards in a game, one of ordinary skill in the art would be able to provide game players with the possibilities of better outcome. Therefore, it would have been obvious to one of ordinary skill in the art . . . to modify Gajor to include a diamond shape, a six six-sided shape . . . [etc.] To do so would be able [sic, enable?] game players to simultaneously evaluate for the highest value."

In paragraph 15, the Examiner stated:

"By having specific card(s) dealt face up or down depending on a particular outcome, it would have been obvious to one of ordinary skill in the art to provide game player [sic] with different possibilities of a better outcome. Therefore it

would have been obvious to one of ordinary skill in the art . . . to include end cards that are dealt face down and are revealed after the player has exchanged cards to provide game players a possible guaranteed payout outcome.”

The Examiner’s conclusion that it would have been obvious to combine these references, however, is inconsistent with the MPEP § 2143.01:

“A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” (Second emphasis supplied; citations omitted).

This obviousness rejection, therefore, is inapplicable.

* * *

None of the prior art references the Examiner has cited, including those considered as pertinent, discloses or suggests exchanging cards or suggests the novel aspects of applicant’s invention.

Wood, for example, uses the word “swap,” but in his game “swapping” only allows players to draw a new card if certain complicated conditions are met. (See col. 2 lines 22 to 56). Applicant’s invention in contrast does not allow the player to draw new cards. Instead, the player must arrange the cards he was dealt into the best hands.

Additionally, Wood is a single hand game. Therefore even if Wood could be considered to have “swapping” as set forth in applicant’s invention, Wood would not include a significant component of applicant’s invention, that is, when a card is swapped from one hand to another, one hand is improved and the other may be worsened.

Finally, as stated in the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior

art also suggests the desirability of the combination.” MPEP § 2143.01 citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)(emphasis in MPEP). The Examiner has not pointed to any motivation to combine any of the references. MPEP § 2144.03 (“When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2)”).

ADDED CLAIMS

The added claims cover games that include the unique aspects of applicant’s invention but use symbols instead of cards.

DOUBLE PATENTING

Although applicant does not believe this application is obvious in view of the co-pending 10/211,063 application, to advance prosecution and to avoid dispute, he is willing to agree to a terminal disclaimer.

INFORMATION DISCLOSURE

Applicant has two co-pending applications both of which were assigned to the same Examiner (10/015,314 and 10/211,063), and a PCT application. The Office Actions for the two U.S. applications were mailed two days apart by the same Examiner. Applicant therefore believes the Examiner is aware of all prior art in both application, but

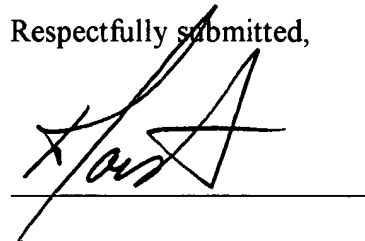
for completeness, Applicant has submitted non-redundant prior art cited in the '063 application and in the PCT search report.

Also, to comply with MPEP § 2001.06(b) and C.F.R. § 1.56, Applicant wants to point out that he also has other co-pending applications related to card games: serial numbers 10/156,381 and 10/081,095.

CONCLUSION

For the foregoing reasons, Applicant believes his invention was neither anticipated nor was obvious in view of the cited prior art. Therefore, applicant respectfully request reconsideration of the claims, together with a favorable determination.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Loewenstein', is written over a horizontal line.

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“MARKED-UP” SET OF AMENDMENTS

Claim 1 (amended once):

1. A video poker game that has cards represented in a four sided, diamond shape[d] [display], each side has five cards, three interior cards and two [the] corner cards, the corner cards are shared with two adjacent hands, [the] a player can exchange cards from one hand to another hand, after the exchange the resulting hands are compared to a pay table.

Claim 10 (amended once):

10. A video poker game that has cards represented in an n-sided display, where n is a number more than 2, each side has five cards, three interior cards and two [the] corner cards, the corner cards are shared with two adjacent hands, [the] a player is dealt the three interior cards face up and the corner cards face down, the player then can exchange cards from one hand to another hand, after the exchange, the resulting hands are compared to a pay table.